

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Ting Tina Ye et al. Confirmation No.: 2367
Serial No.: 09/839,065 Examiner: Matthew F. DeSanto
Filing Date: April 20, 2001 Group Art Unit: 3763
Docket No.: 1001.1471101 Customer No.: 28075
For: MICROCATHETER WITH IMPROVED DISTAL TIP AND TRANSITIONS

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Commissioner for Patents
P.O. Box 1450
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REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 22nd day of May 2009.

By



Kathleen L. Boekley

Dear Sir:

Pursuant to 37 C.F.R. § 41.53, Appellants hereby submit this Request for Rehearing. This paper is filed within two months of the April 1, 2009 mailing date of the Decision on Appeal. Appellants believe that no fees are due. Permission is hereby granted to charge or credit deposit account number 50-0413 for any errors in fee calculation.

Appellants file this Request for Rehearing because the Board misapprehended the Examiner's rejection and, in consequence, affirmed the rejection rather than affirming the result on different reasoning. The Board therefore failed to designate its Decision on Appeal as a new ground of rejection, which has important procedural implications.

One recurring point of disagreement throughout the prosecution has been the interpretation to be given to the phrase in claim 1 "a distal tip having a *shapeable length*..." Appellants have consistently maintained that this is a structural limitation and should be so interpreted. See, for example, page 11 of the Supplemental Appeal Brief of April 9, 2008. The Board agreed, saying "We agree with Appellants that the "shapeable" limitation is not a product by process limitation and we also agree that the word 'shapeable' should be understood as meaning 'capable of being shaped'. Thus it is a material property of a portion of the recited device." Decision on Appeal, page 9 (some quotation marks omitted).

The Board errs in saying that "[t]he Examiner has reasonably established a prima facie case of unpatentability at least based on inherency." Decision on Appeal, page 10. To the contrary, the Examiner has never asserted that "a distal tip having a shapeable length" is a material property of the device inherent in the cited prior art. The Examiner has consistently interpreted this language as a product by process limitation.

For example, the Examiner's Answer (Item 10) says, "The applicant argues that the examiner has interpreted 'shapeable by thermoforming techniques' as a product by process claim recitation. This is not true. The examiner is interpreting that statement as a product by process limitation and has given that limitation the full scope as suggested by the MPEP, in sections 2112.01, 2112.02 and 2113." Emphasis added. The Examiner goes on to say "[Section 2173.05(p)(I)] does not give any insight into how to interpret claims that have process limitations

in an apparatus claim” (page 3-4) and “In claim 1, ‘the distal tip having a shapeable length that is shapeable by thermoforming techniques’, is being interpreted as a functional statement, with a product-by-process limitation” (page 4) and “The next limitation ‘by thermoforming techniques’ is the process limitation, which results in the product being shapeable” (page 5) and “With regards to *In re Thorpe* the examiner used this case law to show that the patentability of the product (the catheter) does not depend on its method of production (thermoforming techniques) but on the finally [sic] product” (page 5), and so on.

The Examiner’s Answer is consistent with the Examiner’s position throughout prosecution. In item 6 on page 5 of the Final Office Action of January 28, 2004, the Examiner writes “the examiner holds the limitation ‘shapeable by thermoforming techniques’ to be a product by process limitation.” In item 6 on page 5 of the Office Action of August 12, 2003, the Examiner writes “since this limitation is a product by process limitation.”

Never in the course of prosecution does the Examiner claim that the “shapeable” limitation is a material property of the recited device, and never does the Examiner assert the inherency of this limitation in Samson.

The reasoning in the Decision on Appeal is based on the “shapeable” limitation being a material property inherent in Samson. This is a substantially different basis for the rejections than product-by-process reasoning advanced by the Examiner. Significantly, Appellants never had an opportunity to respond to a rejection based on inherency because such a rejection was, prior to the Decision on Appeal, never applied.

Appellants therefore request that the Board correct this misapprehension of the Examiner's basis for rejection in the Decision on Appeal by issuing a corrected Decision on Appeal, or its equivalent, that designates the Board's reasoning as a new grounds of rejection.

Respectfully submitted,

Ting Tina Ye, et al.

By their attorney,

Date:

5/22/09



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